

## **REMARKS/ARGUMENTS**

Claims 1-27 are currently pending in this application. Claims 1, 12, 19, and 25 are independent claims. Applicant kindly requests favorable reconsideration of the application in view of the following discussion.

### **DISCUSSION OF EXAMINER'S RESPONSES TO APPLICANT'S ARGUMENTS**

In section "a" on Page 8, the Examiner addresses Applicant's argument/observation that there is no suggestion or motivation to combine the cited prior art references. The Examiner first cites *In re Gorman* stating that the test for the relevance of a cited combination of references is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," 18 USPQ2d at 1888. Although the Examiner notes the law from *In re Gorman*, the current office action demonstrates that the Examiner does not consider the claim limitations as a whole.

The Examiner, instead, prefers to break limitations into many short clauses and then cite different sections of a patent document that purportedly teach those short clauses. For example, claim 12 has three primary limitations. For the first limitation, the Examiner broke this limitation into five pieces and then made piecemeal rejections by submitting a section from Judd to teach each of the pieces of the claim limitation. One clause in this limitation from claim 12 states "reading index information that is associated with a secure graphical or audio object." The examiner artificially separated this clause in to two parts: (1) "reading index information" and (2) "that is associated with a secure graphical or audio object."

Conceivably, one could prove any patent claim obvious by breaking limitations into small pieces. Suppose that in claim 12 the Examiner broke the clause into nine parts: (1) "reading" (2) "index" (3) "information" (4) "associated" (5) "with" (6) "secure" (7) "graphical" (8) "audio" (9) "object." By breaking this limitation into nine pieces it would be extremely simple to cite a group of patent documents that taught each of these words. But this is an obvious error.

The clause "Reading index information" alone is not what is claimed. What is claimed is "reading index information that is associated with a secure graphical or audio

object". The Examiner artificially segmented limitations to to make it easier to suggest that the cited reference(s) teaches the claimed invention.

Next the Examiner explained that there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, but that it is not necessary that the cited reference or prior art specifically suggest making the combination. From this statement the Examiner admits that the combination of Kirsch & Judd does not specifically suggest making the combination. Since the Examiner is aware that Kirsch & Judd make no specific suggestion to combine, the Examiner cited *In re Wood*. *In re Wood* teaches a two-part test to establish a suggestion to combine. Such a suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching IF: (1) a person of ordinary skill in the art is presumed to know the teaching, AND (2) the use of the teaching is used to solve **the same [or] similar problem** which it addresses.

First, the Examiner has not identified what teachings a person of ordinary skill in the art is presumed to know. Secondly, it is unmistakable that the cited references do not teach the same or similar problem that the present invention addresses. Consider the table below that illustrates how unmistakably different the problems are in each invention.

<b><i>INVENTION</i></b>	<b><i>PROBLEM TO SOLVE</i></b>
Present Invention	<u>Visibility</u> - Secure documents owners want their content discoverable online, but they install digital rights management software that restricts a spider's access.
Judd	<u>Spamming</u> - Search engines are being spammed with documents that do not genuinely use descriptive words, documents such as pornographic documents.
Kirsch	<u>Scalability</u> - Search engines index online documents at a rate that is orders of magnitude slower than the rate at which online documents change.

Visibility, spamming, and scalability are the three problems addressed among the inventions. The present invention solves problems related to visibility. Judd solves problems related to Spamming. Kirsch solves problems related to Scalability. None of these problems are the same or similar. The problem of spamming is not the same as the problem of visibility. The problem of Scalability is not the same as the problem of visibility. Additionally, the problems of scalability and spamming are not related. A person of

ordinary skill in the art would not and could not take an invention related to spamming and think "If I combine this spam solution with this scalability solution, then I could make an invention to solve visibility problems." Thus, neither of the cited references—alone or combined—teaches a solution to solve the same or similar problem as the present invention. Therefore there is no basis to combine Judd and Kirsch.

In section "b" on page 9, the Examiner writes that the Applicant argued that Judd teaches a search engine constructing an index, but it does not teach having index information for use in an index database of a search engine system. The Examiner then wrote that Judd teaches "index information for use in an index database of a search engine system" at column 5, lines 55-65, and at column 8, lines 21-40.

Once again, these references miss the mark of what the present invention claims. The sections of Judd referenced by the examiner merely explain the prior art search engines. The last two replies by the Applicant thoroughly demonstrated the difference between the present invention and traditional search engines. The mere citing of this section demonstrates that the Examiner still does not fully understand the presently claimed invention.

In section "c" on Page 9, the Examiner writes "Applicant argues that *Judd does not teach a search engine is restricted.*" In response, the Examiner submitted that Judd teaches a search engine is restricted in column 3, line 2, column 3, line 27, and column 16, lines 47-52.

In column 3, line 2, Judd states: "the tag word indicates that access to the electronic document is restricted." In column 3, line 27 Judd states: "the tag word indicates that access to the electronic document is restricted." In column 16, Judd states: "the tag words are used to limit a Web search to only those documents that have been verified by the third party."

In these sections, Judd teaches that access to the electronic document is restricted, but Judd does not teach that the **search engine** is restricted. In fact, Judd teaches the opposite of the present invention in that Judd teaches that the search engine is doing the restricting, instead of the search engine being restricted. The Examiner failed to read the context of Judd. By a careful reading of Judd it is clear that Judd restricts human access to

indexed documents—not access by by search engine system to un-indexed documents. In Judd, a human makes a query for certain documents. Prior to the query Judd tags index documents that are, for example, pornographic. If Judd determines that the query is unrelated to pornography, then Judd restricts access to tagged documents so that these documents are not displayed to the human user in the search results.

In section "d" on Page 9 of Examiner's responses, the Examiner writes "Applicant argues that *Judd does not teach transmitting index information to a search engine.*" Examiner responds to this by quoting a section of Judd that reads "a search system for the World Wide Web, including a Web crawler or 'spider' system, an index of Web document, and a search engine that can receive a search query and find matching information in the index." The Examiner concludes that this section meets "transmitting index information to a search engine."

Without looking beyond the Examiner's words it is easy to see how there is no foundation at all to the Examiner's conclusion. The claim limitation reads "transmitting index information to a search engine." Yet the quoted reference simply describes a search engine receiving a query and matching information in the index. The quoted section does not teach or suggest transmitting the index information to a search engine, it only teaches making a query at a search engine. The Examiner's response is even more perplexing in light of the telephone interview of November 30, 2005. In the telephone interview, the applicant spoke with the Primary Examiner. Most of the discussion concerned the difference between the presently claimed invention and search engines. The Primary Examiner was able to see how the wording could confuse an examiner, but did notice the difference in "transmitting to a search engine." Since Judd and Kirsch merely teach traditional search engine systems, the Applicant was led to believe that the Examiner would do a search for patent documents that actually related to the present invention. Instead, Applicant has been presented with an Office Action in which the claims were rejected under the same references and for substantially the same reasons that were thought to be resolved in the telephone interview.

In section "e" on Page 10 of Examiner's responses, the Examiner writes that the Applicant argues that Kirsch does not mention "obfuscate." In response, the Examiner

cites column 9, lines 40-46, column 10 lines 8-65, and figure 3, and then suggests that this results in content that is less intelligible. By removing frequently used words, an index may become less intelligible, but this is not obfuscating.

The suggestion that Kirsch teaches obfuscation is a suggestion created only by the Examiner. From a careful reading of the specification of the present invention it is clear what obfuscating is. Claims need to be read in light of the specification. From the specification of the present invention it is clear that to "obfuscate" means more than simply removing frequently used terms (as Kirsch teaches). Plus, Kirsch makes no suggestion about obfuscating or reducing intelligibility. Instead, Kirsch teaches improving the efficiency of an index by removing frequently used words.

### **35 USC § 103**

Claims 1-27 were rejected under 35 USC 103(a) as being unpatentable over Judd in view of Kirsch.

#### **Claim12**

The Office Action stated on page 3 that Judd "teaches a method of providing index information for secure graphical or audio objects" and cited the Abstract. The Abstract, however, does not teach "providing" index information but teaches making index information. Additionally, the Abstract fails to disclose secure graphical or audio objects. Thus this citation was erroneous.

The Office Action stated on page 3 that Judd teaches "reading index information" at col.3, lines 7-8, and "that is associated with a secure graphical or audio object" at col.3, lines 33-45). The first error that the Examiner made in this citation is splitting the claim limitation clause. There is no comma or punctuation to justify such a separation and piecemeal rejection. By separating the clause the, Examiner can try to show sections of prior art that mention similar words to the separated clauses, and then make the illogically assumption that the Prior art teaches this limitation. Unless the prior art teaches or suggests the whole limitation, then a person of ordinary skill in the art is not going to string together a bunch of words and phrases to produce the present invention. What if the Examiner separated this clause into individual words? It would then be easy to find a

group of prior art references that can be cited to teach each individual word. But does that make it obvious? Of course not. The whole claim limitation clause is "reading index information that is associated with a secure graphical or audio object." Judd does not teach or suggest this limitation. Furthermore, Judd is silent on the terms "secure", "graphical", "audio", and their equivalents.

The Office Action stated on page 3 that "wherein the index information is structured for use in an index database of a search engine system" is taught by Judd at column 15, lines 3-16. In this section of Judd, it appears the Examiner merely did a term search for "index" and "structure". This section describes an index that may have support structures. It uses "structures" as a noun, not as a verb. These support structures are nodes across which a word index is distributed. Thus this section does not teach index information associated with a secure graphical object that is structured for use in an index database of a search engine system.

The Office Action stated on page 3 that "wherein the search engine systems do not have full access to the secure graphical or audio object" is taught by Judd at column 3, lines 21-32. Judd does not teach this. Judd teaches restricted access, but Judd is a search engine and the access being restricted is the access of a human. Recall that Judd relates to solving the problem of search engine spamming. As a search engine, Judd tags documents it indexes that are, for example, pornographic, but contain terms relevant to unrelated searches. When a human enters a search for a term unrelated to pornography, Judd restricts search results from displaying the tagged documents. In Judd, the search engine is managing the restricted access. In the present invention, it is the opposite: a non-search engine is restricting a search engine from accessing secure documents.

The Office Action stated on page 3 that "wherein search engine do not have access to the index information associated with the secure graphical or audio object," is taught by Judd at column 3, line 2 to column 3 lines 3 & 24-27. Judd does not teach this. As discussed in the above paragraph, Judd does not teach restricting search engines from accessing secure graphical or audio content.

The Office Action stated on page 3 that "transmitting the [obfuscated] index information to the search engine system," is taught by Judd at column 5, lines 53-56 and at figure 1. This section of Judd teaches the traditional search engine system process, and thus teaches away from the present invention. Judd teaches a search engine spider or

crawler accessing whole web documents so that the entire web document is received by the search engine system. Then the search engine system creates an index of the document. In the present invention, the method does not transmit entire web documents to spiders. Instead, in the method of the present invention, the invention creates its own index, and then transmits this index to the search engine system. In the telephone interview of 11/30/05, much of the discussion with the Primary Examiner revolved around this point. While the Primary Examiner mentioned that the wording could confuse an examiner, the Primary Examiner noticed the subtle distinction of "transmitting to a search engine." This subtle distinction makes a huge difference between the presently claimed invention and the cited prior art. Thus, Judd does not teach or suggest this limitation.

The Office Action stated on pages 3-4 that "wherein the index information is for use in the index database of the search engine system," is taught by Judd at column 5, lines 55-65, and at column 8, line 21 "Search The Index." This limitation modifies the previous limitation. As discussed above in the previous limitation, Judd does not teach preparing index information outside of the search engine system. Both of these cited sections merely describe the traditional search engine system.

The Office Action stated on page 4 that Kirsch teaches "obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced" at column 9, lines 40-46, column 10, lines 8-65, and also at figure 3. In these sections, Kirsch teaches using a stop list, but does not not teach obfuscating. Kirsch teaches using a stop list to "improve contextual significance," not to obfuscate. The stop list in Kirsch maintains a list of frequently used words and phrases with no substantive content. These unimportant words are removed to keep the index information efficient and logical. Thus Kirsch actually teaches away from the present invention.

Furthermore, by simply removing common prepositions and common words, as Kirsch teaches, much of the intelligibility remains. For example, consider this sentence from the specification: "Microsoft has hired the largest credit card authorization and processing company in the world to handle transactions placed on the Microsoft Network." Kirsch teaches removing common words to produced an efficient database. Kirsch would analyze this sentence and remove contextually insignificant words so that the resulting sentence reads: "Microsoft hired largest credit card authorization processing company world handle transactions placed Microsoft Network." While the common words are

missing, the sentence is still very intelligible. Most people could understand this sentence. The present invention, however, actually obfuscates the index information. By using the present invention and obfuscating at least a portion of the index information, the resulting index information could read: "hired, microsoft, if, but, largest credit card authorization, was, while, processing company, world, some, msn, handle transactions placed, too, microsoft network." This resulting group of words is actually obfuscated and less intelligible.

From the discussion above, the combination of Judd and Kirsch does not teach or suggest all the claim limitations. Indeed, the combination of Judd and Kirsch does not teach most of the limitations of claim 12. By not teaching most of the limitations of claim 12, the reference combination fails to meet one of the basic criteria required to establish a prima facie case of obviousness, according to MPEP § 2143.

A second basic criterion of obviousness that the reference combination failed to meet is that there is no suggestion or motivation to modify or combine the references, MPEP § 2143. As the Examiner implied, there is no explicit motivation to modify or combine Judd & Kirsch. As the Applicant discussed in the tables above, there is no common teaching in the reference combination that is used to solve the same or similar problem that the present invention addresses. This is demonstrated by considering the problems that each invention aims to solve. Judd relates to spamming, Kirsch to scalability, and the present invention to visibility. Considering solutions for spamming and scalability does not cause a person of ordinary skill in the art to think about solving problems of visibility of secure objects.

Because the reference combination (1) fails to teach or suggest all the claim limitations, and (2) lacks any suggestion or motivation to combine the references, the presently claimed invention is patentable over Judd and Kirsch. Claim 12 is therefore believed to be allowable.

### **Claims 13-18**

Claims 13 -18 depend on claim 12, and incorporate all of the limitations of claim 12. Because independent claim 12 is patentable over the reference combination, claims 13-18 are likewise patentable over the reference combination. Therefore claims 13-18 are believed to be allowable.



### **Claim 1**

The Office Action stated Judd additionally teaches "converting at least a portion of a secure audiovisual object into index information" citing column 10, lines 19-36. This cited section does not teach what the Examiner suggests. Instead, this section teaches the process by which Judd attaches tags to indexed documents to label such documents to identify spam. Additional limitations of claim 1 are substantially similar to the limitations of claim 12. The above reasons for claim 12 being allowable over the reference combination are thus applicable for claim 1. Claim 1, therefore, is believed to be allowable over the reference combination.

### **Claims 2-11**

Claims 2 -11 depend on claim 1, and incorporate all of the limitations of claim 1. Because independent claim 1 is patentable over the reference combination, claims 2-11 are likewise patentable over the reference combination. Therefore claims 2-11 are believed to be allowable.

### **Claim 25**

Claim 25 is substantially similar to claim 1 in its first and third limitations. The above reasons for claim 1 being allowable over the reference combination are thus applicable for claim 25. Claim 25 also claims "dynamically generating an electronic document based at least in part upon the contents of the index information." The Office Action stated that Kirsch (col.4, lines 17-27) teaches dynamically generating an electronic document based at least in part upon the contents of the index information. This is wrong because Kirsch actually teaches dynamically integrating documents into an index (as part of Kirsch's solution to scalability problems). Kirsch does not teach dynamically generating an electronic document based at least in part upon the contents of the index information. Additional limitations of claim 25 are substantially similar to the limitations of claim 12. The above reasons for claim 12 being allowable over the reference combination are thus applicable for claim 25. For this and the above listed reasons, claim 25 is patentable over the reference combination and believed to be allowable.

### **Claims 26 & 27**

Claims 26 & 27 depend on claim 25, and incorporate all of the limitations of claim 25. Because independent claim 25 is patentable over the reference combination, claims 26 & 27 are likewise patentable over the reference combination. Therefore claims 26 & 27 are believed to be allowable.

### **Claim 19**

Claim 19 is a system claim that is substantially similar to the process of claim 25. The above reasons for claim 25 being allowable over the reference combination are thus applicable for claim 19. Claim 19, therefore, is believed to be allowable over the reference combination.

### **Claims 20-24**

Claims 20-24 depend on claim 19, and incorporate all of the limitations of claim 19. Because independent claim 19 is patentable over the reference combination, claims 20-24 are likewise patentable over the reference combination. Therefore claims 20-24 are believed to be allowable.

### **Prior Art Made of Record**

The Applicant has reviewed the prior art made of record, not relied upon, but considered pertinent to applicant's disclosure.

- Knauff et al. USPN 6,981,217: The Examiner erroneously cited this patent because it is related to the present invention. This patent and the present invention have the same inventor and both claim priority to the same provisional patent application. In the parent case text, this patent states it is related to "U.S. application Ser. No. 09/456,793" (the present invention).
- Caid et al., USPN 5,794,178: Caid does not relate to visibility, but instead relates to "generating and retrieving context vectors that represent high-dimensional abstractions of information content."

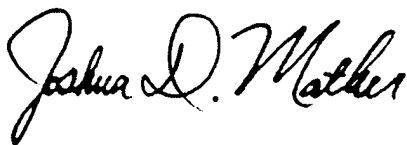
- Burrows, USPN 5,864,863: Burrows relates to scalability like Kirsch.
- Meyerzon et al., USPN 6,547,829: Meyerzon relates to solving the problem of indexing duplicate documents from a database, and does not teach visibility.
- Huang et al., USPN, 6,895,551: Huang relates to validation of web pages and identification of authors.
- Collerg, et al., "A Taxonomy of Obfuscating Transformation": Collerg relates to the problem of software competitors extracting proprietary algorithms and data structures from Java applications to use for their own purpose. It suggests that code obfuscation is the most reasonable approach to deter this algorithm theft.

### Summary

Applicant is a pioneer in its market. This application is one of a family of applications filed by the Applicant in 1999, of which two have already issued, and another has been allowed. The reason that no prior art anticipates or makes obvious the present invention is because the applicant invented it.

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,



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